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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

742113-33

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Signature _____

Typed or printed name _____

Application Number

10/523,924

Filed

03-28-2005

First Named Inventor

Carsten HERMANSEN et al.

Art Unit

3724

Examiner

Clark F. Dexter

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.


I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 27,997

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

David S. Safran

Typed or printed name

703-584-3273

Telephone number

October 1, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of)
Carsten HERMANSEN et al.) Art Unit 3724
Application No. 10/523,924) Examiner Clark F. Dexter
Filing Date: March 28, 2005) Confirmation No. 1913
For: DEVICE AND METHOD FOR)
THROUGH-CUTTING OF AN)
EXTRUDED ICE MASS)

STATEMENT IN SUPPORT OR REQUEST FOR PRE-APPEAL BRIEF REVIEW

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner has objected to the drawings and rejected claims 1-14 under 35 USC § 112, first paragraph for failing to comply with the written description requirement for failing to show and adequately describe the claimed structure to simultaneously drive the knives and to provide the knives with different stroke lengths (claim 1) and more specifically, the rotor means, coupling means and drive means (claim 5). In this regard, while stated to be a rejection for failure to comply with the written description requirement, the Examiner's comments read as if the rejection was based on a failure to provide an enabling disclosure so that this rejection will be addressed from both standpoints.

Considering first the written description requirement, as correctly noted by the Examiner, the specification need only "reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the invention." Furthermore, in the guidelines of MPEP § 2163 it is set forth that:

The examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that

an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191

Here, the Examiner has not met that burden in that subject matter supposedly not shown to be in the possession of the invention was present in claims 1 and 5 as originally filed, and their subject matter is described in the specification in the paragraph spanning pages 3 & 4 as well as in the text running from page 6, line 5 through page 7, line 13. Nothing in the Examiner's rejection adequately explains why one of ordinary skill would not recognize such descriptions as showing that the applicants' were not in possession of the claimed invention. As also pointed out in the guidelines of MPEP § 2163:

If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., "in the same words"] to be sufficient").

Clearly, applicants' disclosure fulfills the written description require meeting all of the standards set forth for doing so in the case law and as proscribed in the MPEP.

However, as noted initially, while stated to be a written description rejection, comments by the Examiner as to features that are "not sufficiently disclosed" and it not being "clear as to how they [i.e., certain elements] interact" show a confusion on the Examiner's part as to the differences between the written description requirement and the enablement requirement of § 112, first paragraph. Since the Examiner has justified his written description requirement rejection on alleged failures to adequately disclose how to make and use the invention, the adequacy of the disclosure to enable one of ordinary skill to practice the invention will now be described.

As the Examiner was advised, the second gear mechanism 14 used by the present applicants and disclosed in this application was derived from a text book relating to the field of lever mechanisms, i.e., *MECHANISMS in Modern Engineering Design, Volume I: Lever Mechanisms* by Ivan I. Arobolevsky, D.Sc. (Eng.), Mir Publishers, Moscow, 1975 (hereafter, "Modern Engineering"), a copy of title pages and pages 512, 513 having been provided to the

Examiner with applicants response filed March 9, 2009. Thus, this publication provides evidence of that which was well-known to those skilled in the art well prior to the present invention and demonstrates that the drawings on file, in fact, show the claimed invention.

In particular, it can be seen that the knife driving arrangement shown in Fig. 5 is comprised of a first gear mechanism 15 that is a simple eccentric crank mechanism the operation of which is very basic and is well known to even basic engineering students and a second gear mechanism 14. The second gear mechanism 14 is a “long-dwell mechanism” as is shown and described at the top of page 513 of the Modern Engineering reference and the second knife 5 of Fig. 5 is connected to a lever that corresponds to “link 4” of Modern Engineering figure. As described in Modern Engineering, the second knife 5 would have a dwell at its most extended position which is approximately equal to a half-revolution of the crank part of the second gear mechanism 4.

More specifically, when the rotor means 10 of the present invention drives the crank parts of the first and second gear mechanisms 15, 14, simultaneously, as indicated in Fig. 3, the first and second knives 4, 5, are caused to be reciprocated simultaneously as required by claims 1-5 and as described in paragraph [0027]. After an initial motion of the two knives relative to each other, due to the dwell produced by the second gear mechanism 14, the second knife 5 will virtually stop while the first knife 4 continues its reciprocating motion and cuts the ice slice after which both knives return to their initial positions.

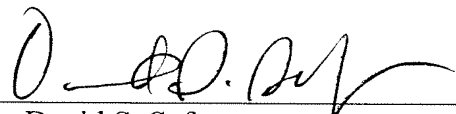
Furthermore, the drawings do, in fact, illustrate the claimed subject matter to the extent required by 37 CFR 1.83(a) and Figs. 4 & 5 actually show a level of detail beyond that required for structure of such a simple mechanical type that uses known drive principals so that, as pointed out in the following citations set forth in MPEP § 2164.01:

United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987).

Can it seriously be argued given the lengthy history and extensive available knowledge with respect to mechanical drive linkages and the cited text in particular, that anyone having even basic mechanical skills and knowledge of mechanical drive mechanisms would be unable to create the claimed drive without any real experimentation at all, let alone “undue” experimentation? The Examiner has merely stated conclusions as to what is “not sufficiently disclosed” without one iota of explanation as to why, given the evidence presented and the descriptions and illustrations provided, coupled with the simplicity of the art involved and extensive knowledge of the prior art in the mechanical drive field, why a person of ordinary skill would not find the claimed aspects forming the grounds for this rejection to be adequately disclosed. For example, what is there about the known drive submitted that would preclude it from performing the claimed functions or at least being adapted to do so without undue experimentation? Once being told the motions to be produced, given what has been evidence to have been know in the prior art, it is simply inconceivable that a person of ordinary skill could not produce multiple different drive means capable of producing such motions using standard principals without any real effort at all.

On the basis of the foregoing, the panel is urged to overturn the Examiner’s rejection and objection (which the Decision on Petition dated August 14, 2009 linked to the outstanding written description rejection).

Respectfully submitted,

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